

RECEIVED  
CENTRAL FAX CENTER

NOV 22 2006

PATTERSON &  
SHERIDAN, LLP

ATTORNEYS AT LAW

3040 Post Oak Blvd, Suite 1500  
Houston, TX 77056-6582  
TEL 713.623.4844  
FAX 713.623.4846

## FACSIMILE COVER SHEET

**DATE:** September 22, 2006

**FILE NO:** ROC920030266US1 (IBMK30266)

**TO:** MAIL STOP APPEAL BRIEF - PATENTS  
Examiner James J. Debrow

**FAX NO:** 1-571-273-8300

**FROM:** Randol W. Read/Christopher Shannon

**PAGE(S) with cover:** 22

**RE:**

**TITLE:** MAINTAINING ANNOTATIONS FOR DISTRIBUTED AND VERSIONED FILES

**U.S. SERIAL NO.:** 10/757,792

**FILING DATE:** 1/15/04

**INVENTOR(S):** Cragun et al.

**EXAMINER:** James J. Debrow

**GROUP ART UNIT:** 2176

**CONFIRMATION NO.:** 5430

Attached are the following document(s) for the above-referenced application:

Appeal Brief

### CONFIDENTIALITY NOTE

The document accompanying this facsimile transmission contains information from the law firm of Patterson & Sheridan, L.L.P. which is confidential or privileged. The information is intended to be for the use of the individual or entity named on this transmission sheet. If you are not the intended recipient, be aware that any disclosure, copying, distribution or use of the contents of this faxed information is prohibited. If you have received this facsimile in error, please notify us by telephone immediately so that we can arrange for the retrieval of the original documents at no cost to you.

503326\_1

RECEIVED  
CENTRAL FAX CENTER

NOV 22 2006

PATENT  
Atty. Dkt. No. ROC920030266US1  
PS Ref. No.: IBMK30266**TABLE OF CONTENTS**

1.	Identification Page.....	1
2.	Table of Contents .....	2
3.	Real Party in Interest .....	3
4.	Related Appeals and Interferences .....	4
5.	Status of Claims .....	5
6.	Status of Amendments .....	6
7.	Summary of Claimed Subject Matter .....	7
8.	Grounds of Rejection to be Reviewed on Appeal .....	8
9.	Arguments .....	9
10.	Conclusion .....	14
11.	Claims Appendix .....	15
12.	Evidence Appendix .....	20
13.	Related Proceedings Appendix .....	21

RECEIVED  
CENTRAL FAX CENTER

NOV 22 2006

PATENT  
Atty. Dkt. No. ROC920030266US1  
PS Ref. No.: IBMK30266IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCESIn re Application of:  
Cragun et al.

Serial No.: 10/757,792

Filed: 1/15/04

For: MAINTAINING ANNOTATIONS  
FOR DISTRIBUTED AND  
VERSIONED FILES§  
§  
§  
§  
§  
§  
§  
§  
§  
§

Confirmation No.: 5430

Group Art Unit: 2176

Examiner: James J. Debrow

13

MAIL STOP APPEAL BRIEF - PATENTS  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

## CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, or facsimile transmitted to the U.S. Patent and Trademark Office to fax number 571-273-8300 to the attention of Examiner James J. Debrow, on the date shown below:

November 22, 2006  
Date

Christopher T. Shannon

## APPEAL BRIEF

Applicants submit this Appeal Brief to the Board of Patent Appeals and Interferences on appeal from the decision of the Examiner of Group Art Unit 2176 dated June 22, 2006, finally rejecting claims 1-20. The final rejection of claims 1-20 is appealed. This Appeal Brief is believed to be timely since it is facsimile transmitted by the due date of November 22, 2006, as set by the filing of a Notice of Appeal on September 22, 2006. Please charge the fee of \$500.00 for filing this brief to Deposit Account No. 09-0465/ROC920030266US1.

11/27/2006 EFLORES 00000092 090465 10757792

01 FC:1402 500.00 DA

RECEIVED  
CENTRAL FAX CENTER

+ USPTO

015/022

NOV 22 2006

PATENT  
Atty. Dkt. No. ROC920030266US1  
PS Ref. No.: IBMK30266**CONCLUSION**

Applicants respectfully submit that the Examiner errs in finding that claims 1, 4, 7-13, and 16-20 are unpatentable over *Fairchild et al.* in view of *Gupta et al.* under 35 U.S.C. § 103(a). Withdrawal of the rejection and allowance of all claims is respectfully requested.

Applicants respectfully submit that the Examiner errs in finding that claims 2, 3, 5, 6, 14 and 15 are unpatentable over *Fairchild et al.* in view of *Gupta et al.*, further in view of *Sidana* under 35 U.S.C. § 103(a). Withdrawal of the rejection and allowance of all claims is respectfully requested.

Respectfully submitted, and  
S-signed pursuant to 37 CFR 1.4,

/Randol W. Read, Reg. No. 43876/

Randol W. Read

Registration No. 43,876

Patterson & Sheridan, L.L.P.

3040 Post Oak Blvd. Suite 1500

Houston, TX 77056

Telephone: (713) 623-4844

Facsimile: (713) 623-4846

Attorney for Appellant(s)

PATENT  
Atty. Dkt. No. ROC920030266US1  
PS Ref. No.: IBMK30266

**Real Party in Interest**

The present application has been assigned to International Business Machines Corporation, Armonk, New York.

PATENT  
Atty. Dkt. No. ROC920030286US1  
PS Ref. No.: IBMK30266

### **Related Appeals and Interferences**

Applicant asserts that no other appeals or interferences are known to the Applicant, the Applicant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

RECEIVED  
CENTRAL FAX CENTER

→ USPTO

006/022

NOV 22 2006

PATENT  
Atty. Dkt. No. ROC920030266US1  
PS Ref. No.: IBMK30266

### Status of Claims

Claims 1-20 are pending in the application. Claims 1-20 were originally presented in the application. Claims 1-20 stand finally rejected as discussed below. The final rejections of claims 1-20 are appealed. The pending claims are shown in the attached Claims Appendix.

PATENT  
Atty. Dkt. No. ROC920030266US1  
PS Ref. No.: IBMK30268

### **Status of Amendments**

All claim amendments have been entered by the Examiner. No amendments to the claims were proposed after the final rejection.



NOV 22 2006

PATENT  
Atty. Dkt. No. ROC920030266US1  
PS Ref. No.: IBMK30266**Summary of Claimed Subject Matter**

Claimed embodiments of the invention provide methods and apparatus for maintaining annotations for changing source documents. (See, e.g., p. 5, paragraph 21.)

Claims 1, 13, and 17 provide a method, computer readable medium, and system, respectively for managing annotations. These claims recite similar operations that include detecting one or more changes to a document having at least one annotation corresponding to at least one portion of the document prior to occurrence of the one or more changes, determining if the at least one annotation should be applied to the document, as changed, based on whether one of a set of one or more policies determining how annotations should be applied to different versions of the same document has been selected, and if the annotation should be applied to the document, updating an annotation record based on the one or more changes to the document. (See, e.g., Figure 6; paragraphs [0056]-[0057].)

Claim 8 provides a method for processing a document. The method generally includes receiving a document to be checked into a content management system, wherein the document having at least one annotation, the annotation corresponds to a portion of the document, and one or more changes to the document have been made subsequent to creation of the annotation. The method further includes determining if the annotation should be applied to the document as changed, by determining whether a creator of the annotation specified the annotation should be applied to subsequent versions of the document and, if it is determined that the annotation should be applied to the document as changed, updating an annotation record containing the at least one annotation based on the one or more changes to the document. (See, e.g., Figure 7; paragraphs [0061]-[0062].)

PATENT  
Atty. Dkt. No. ROC920030266US1  
PS Ref. No.: IBMK30266

### **Grounds of Rejection to be Reviewed on Appeal**

Claims 1, 4, 7-13, and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Fairchild et al.* (U.S. Patent No. 6,728,760 B1, hereinafter *Fairchild*) in view of *Gupta et al.* (Pub. No. US 2003/0196164 A1, hereinafter "*Gupta*").

Claims 2, 3, 5, 6, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Fairchild* in view of *Gupta*, further in view of *Sidana* (U.S. Patent No. 6,571,295 B1).

RECEIVED  
CENTRAL FAX CENTER

NOV 22 2006

PATENT  
Atty. Dkt. No. ROC920030266US1  
PS Ref. No.: IBMK30266**ARGUMENTS****Obviousness of Claims 1, 4, 7-13, and 16-20 over *Fairchild* in view of *Gupta******The Applicable Law***

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143.

The present rejection fails to establish at least the third criterion.

***The References***

*Fairchild* is directed to a method of optimizing delivery of computer media over a network of computers. Abstract. In *Fairchild* an annotation record is created for each item of computer media. (Column 6, Lines: 30-32.) If a computer media item is updated or deleted, the annotation record is updated and a notification is forwarded to other computers via the network of computers. (Column 6, Lines: 59-65.)

*Gupta* is directed to associating annotations with multiple media streams of the same multimedia content. (Column 2, Lines: 50-51.) In *Gupta* a multimedia file (e.g., audio or video) may be stored in multiple versions or media streams, wherein the media streams have the same multimedia content yet vary in terms of resolution quality or bandwidth requirements. (Column 2, Lines: 14-22.) The multimedia content may have various streams such that a user may select one to download one according to his/her access bandwidth. Id. In *Gupta* an annotation for one of the media streams of the

PATENT  
Atty. Dkt. No. ROC920030266US1  
PS Ref. No.: IBMK30266

same multimedia content is applied to all of the media streams containing the same multimedia content. (Column 2, Lines: 53-59.)

### *The Examiner's Argument*

The Examiner concedes that Fairchild fails to teach the claim 1, 13, and 17 limitation of "determining if the at least one should be applied to the document as changed, based on whether one of a set of one or more policies determining how annotations should be applied to different versions of the same document has been selected." (Page 4 of Examiner's Final Office Action mailed June 22, 2006; hereinafter "Examiner's Final Action".) Additionally, the Examiner concedes that Fairchild fails to teach the similar claim 8 limitation of "determining if the annotation should be applied to the document as changed, by determining whether a creator of the annotation specified the annotations should be applied to subsequent versions of the document." (Page 6 of Examiner's Final Office Action.)

However, the Examiner states that *Gupta* teaches these elements. (Page 4 and Page 6-7 of Examiner's Final Office Action.)

### *Applicants' Response to the Examiner's Argument*

Applicants respectfully submit that *Gupta* as a whole, fails to teach "determining if the at least one annotation should be applied to the document, as changed, based on whether one of a set of one or more policies determining how annotations should be applied to different versions of the same document has been selected" as recited in claims 1, 13, and 17. Furthermore, Applicants submit that *Gupta* fails to teach the claim 8 limitation of "determining if the annotation should be applied to the document as changed, by determining whether a creator of the annotation specified the annotations should be applied to subsequent versions of the document."

The Examiner argues that *Gupta* teaches determining if the at least one annotation should be applied to the same document, as changed in paragraphs [0095]-[0096], paragraph [0104], and element 306 in Figure 9 of *Gupta*. A careful review of the

PATENT  
Atty. Dkt. No. ROC920030266US1  
PS Ref. No.: IBMK30266

portions of *Gupta* cited by the Examiner shows an absence of any teaching of an affirmative action as recited in the claims. Rather, the *Gupta* reference describes determining which media streams/files correspond to the same annotated multimedia media content, and applies the annotation to those media files without regard to change of a document or any type of decision as to whether or not an annotation should be applied to a document.

In *Gupta*, before an annotation is even created, multiple media streams (files), containing the same content, are created to provide multiple download options for a viewer/listener of the media content. (Page 4, paragraph [0049].) These different media streams make up the "versions" of multimedia content referred to in *Gupta*. (Page 1, paragraph [0007], lines 1-3; Page 4, paragraph [0049], lines 13-15.) Thus, when the *Gupta* reference refers to different "media versions," it is not referring to the same document, as changed as recited in the claims. In contrast, different "media versions" in *Gupta* refers to a plurality of files/media streams having the same multimedia content.

In *Gupta*, once a user enters an annotation for a particular media stream, the equivalent media streams are found which containing the same multimedia content. (Page 8, paragraph [0095], lines 11-19; paragraph [0104], lines 1-2.) After finding the equivalent media streams, identifiers are added to the annotation to identify the media streams to which the annotation applies. (Page 8, paragraph [0105], lines 1-2.) However, *Gupta* does not determine whether or not an annotation should be applied to the same document as changed, rather *Gupta* applies an annotation to different media streams that contain the same multimedia content.

#### Second Argument:

Applicants respectfully submit that the cited portion of *Gupta* and, in fact, *Gupta* as a whole, fails to teach selection of one or more of a set of policies determining how annotations should be applied to different versions of the same document. A careful review of the sections cited by the Examiner shows that the *Gupta* reference makes no mention of policies to determine how annotations should be applied. Furthermore, in contrast to a set of policies of determining how annotations should be applied to

PATENT  
Atty. Dkt. No. ROC820030286US1  
PS Ref. No.: IBMK30286

different versions of the same document, in *Gupta* annotations are always applied when equivalent media streams are found which contain the same multimedia content as the media stream being annotated with no regard to any type of policies. (Page 8, paragraphs [0104]-[0105].) Thus, Gupta does not disclose a set of policies determining how annotations should be applied to different versions of the same document.

Furthermore, in *Gupta* there is no mention of an option or an interface which would allow selection of a policy which would determine how annotations should be applied to different versions of the same document. However, with respect to claim 8, the Examiner argues in the Final Office Action that Gupta discloses determining whether a creator of the annotation specified the annotation should be applied to subsequent versions of the document at paragraphs [0082]-[0086] and Figure 8. (Final Office Action Page 6). The Examiner further states "at least one of the UI preferences could be an option for the creator of the annotation to specify whether the annotations should be applied to the subsequent versions of the document." (Final Office Action Page 7).

However, paragraphs [0082]-[0086] of Gupta, which describe Figure 8, are completely void of any suggestion or teaching of an option allowing selection of a policy which would determine how annotations should be applied to different versions of the same document. Furthermore, as described above, rather than allow a user to select a policy which would determine how annotations should be applied to different versions of the same document, *Gupta* always applies annotations when media streams contain the same multimedia content. (Page 8, paragraphs [0104]-[0105].) Therefore, with respect to claims 1, 13, and 17 Gupta fails to teach, show or suggest selection of one or more of a set of policies determining how annotations should be applied to different versions of the same document. Similarly, with respect to claim 8 Gupta fails to teach determining whether a creator of the annotation specified the annotation should be applied to subsequent versions of the document.

*The Examiner's Response to Applicants' Arguments*

PATENT  
Atty. Dkt. No. ROC920030266US1  
PS Ref. No.: IBMK30266

Applicants now refer to the Examiner's response to the Applicants arguments presented in the Advisory Action (See continuation Sheet of Advisory Action dated 9/1/2006). In the Advisory Action the Examiner states:

"while *Gupta*'s teaching in the cited reference are applied to multimedia content, the Examiner believes that at the time of the invention, a person of ordinary skill in the art could apply the concept that *Gupta* teaches to documents." (Id.)

It appears the Examiner concedes that *Gupta* does not teach applying annotations to documents as changed. Further, the Examiner's response does not address the deficiency that *Gupta* does not teach applying an annotation to a document, as changed, based on whether one of a set of one or more policies determining how annotations should be applied to different versions of the same document has been selected, as recited in the claims.

For these reasons, Applicants respectfully submit that independent claims 1, 8, 13 and 17, as well as their dependents, are allowable.

**Obviousness of Claims 2, 3, 5, 6, 14, and 15 over *Fairchild* In view of *Gupta* and in further view of *Sidana***

Claims 2, 3, 5, 6, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Fairchild*, in view of *Gupta*, and further in view of *Sidana*. However, for the reasons described above, *Fairchild* and *Gupta* fail to teach or suggest all the claim limitations of the independent claims upon which these dependent claims depend. Furthermore, applicants submit that *Sidana* also fails to overcome the deficiencies of *Fairchild* and *Gupta* with respect the independent claims described above. For these reasons, Applicants submit these claims are also allowable, and allowance of the claims is respectfully requested.

RECEIVED  
CENTRAL FAX CENTER

NOV 22 2006

PATENT  
Atty. Dkt. No. ROC920030266US1  
PS Ref. No.: IBMK30266

**CLAIMS APPENDIX**

1. (Previously Presented) A method for managing annotations comprising:  
detecting one or more changes to a document having at least one annotation corresponding to at least one portion of the document prior to occurrence of the one or more changes;  
determining if the at least one annotation should be applied to the document, as changed, based on whether one of a set of one or more policies determining how annotations should be applied to different versions of the same document has been selected; and  
if so, updating an annotation record based on the one or more changes to the document.
2. (Original) The method of claim 1, wherein updating the annotation record comprises updating an index indicating an annotated portion of the document.
3. (Original) The method of claim 1, wherein updating the annotation record comprises updating one or more indexes to refer to multiple versions of the document.
4. (Original) The method of claim 1, wherein updating an annotation record containing the at least one annotation to reflect the one or more changes to the document comprises:  
copying an existing annotation record referring to the document prior to the one or more changes; and  
updating the annotation record copied to reflect the one or more changes to the document.
5. (Original) The method of claim 1, wherein detecting one or more changes to the document comprises comparing change detection values generated for the at least one annotated portion of the document prior to and after the one or more changes.



PATENT  
Atty. Dkt. No. ROC920030266US1  
PS Ref. No.: IBMK30266

6. (Original) The method of claim 5, wherein the change detection values are hash values generated for the at least one annotated portion of the document prior to and after the one or more changes.
7. (Original) The method of claim 1, further comprising, prior to updating the annotation record:
- notifying a user the document has changed; and
  - receiving validation from the user that the annotation should be applied to the document as changed.
8. (Previously Presented) A method comprising:
- receiving a document to be checked into a content management system, the document having at least one annotation corresponding to an annotated portion thereof, wherein one or more changes to the document have been made subsequent to creation of the annotation;
  - determining if the annotation should be applied to the document as changed, by determining whether a creator of the annotation specified the annotation should be applied to subsequent versions of the document; and
  - if so, updating an annotation record containing the at least one annotation based on the one or more changes to the document.
9. (Previously Presented) The method of claim 8, wherein determining if the annotation should be applied to the document as changed comprises determining whether a creator of the annotation specified the annotation should be applied to subsequent versions of the document by selecting a policy from a set of policies that determine how annotations should be applied to subsequent versions of the document.
10. (Previously Presented) The method of claim 9, further comprising:
- determining if the user selected a policy that specifies that validation should occur prior to updating an annotation record containing the at least one annotation to reflect the one or more changes to the document;
  - if so, prompting a user for such validation; and
  - updating the annotation record only after receiving such validation.

11. (Original) The method of claim 8, wherein updating an annotation record containing the at least one annotation to reflect the one or more changes to the document comprises:

running an algorithm to identify the annotated portion of the document corresponding to the at least one annotation in the document as changed; and  
if the annotated portion is identified by the algorithm, updating the annotation record based on results of running the algorithm.

12. (Original) The method of claim 11, further comprising, if the annotated portion is not identified by the algorithm:

prompting a user to identify the annotation portion in the document, as changed;  
and  
updating the annotation record based on input received from the user.

13. (Previously Presented) A computer-readable medium containing a program which, when executed by a processor, performs operations comprising:

detecting one or more changes to a document having at least one annotation corresponding to at least one portion of the document prior to the one or more change;  
determining if an annotation corresponding to at least one annotated portion of the document prior to the change should be applied to the document, as changed, based on whether one or more of a set of one or more policies determining how annotations should be applied to different versions of the same document has been selected; and

if so, updating an annotation record containing the at least one annotation to based on the one or more changes to the document.

14. (Original) The computer-readable medium of claim 13, wherein updating the annotation record comprises updating an index indicating an annotated portion of the document.

15. (Original) The computer-readable medium of claim 13, wherein updating the annotation record comprises updating generating a change detection value for the document, or a portion of the document, to reflect the one or more changes.

PATENT  
Atty. Dkt. No. ROC920030266US1  
PS Ref. No.: IBMK30266

16. (Original) The computer-readable medium of claim 13, wherein updating an annotation record containing the at least one annotation to reflect the one or more changes to the document comprises:

copying an annotation record referring to the document prior to the one or more changes; and

updating the annotation record copied to reflect the one or more changes to the document.

17. (Previously Presented) A system comprising:

at least one application;

a content management system for managing a plurality of documents manipulated by the at least one application;

an annotation database for holding annotation records, each containing annotation data related to one or more of the plurality of documents; and

an annotation maintenance component configured to detect changes to a document managed by the content management system, the document having at least one annotation corresponding to an annotated portion thereof, wherein one or more changes to the document have been made subsequent to creation of the annotation, determine if the annotation should be applied to the document as changed based on whether one or more of a set of one or more policies determining how annotations should be applied to different versions of the same document has been selected, and, if so, update an annotation record containing the at least one annotation based on the one or more changes to the document.

18. (Original) The system of claim 17, wherein the annotation maintenance component is configured to update an annotation record containing the at least one annotation to reflect the one or more changes to the document by updating an annotation index stored in the annotation record.

19. (Original) The system of claim 17, wherein the annotation maintenance component is configured to update an annotation record containing the at least one

PATENT  
Atty. Dkt. No. ROC920030266US1  
PS Ref. No.: IBMK30266

annotation to reflect the one or more changes to the document by updating a change detection value stored in the annotation record.

20. (Original) The system of claim 17, wherein the annotation maintenance component is integrated with the content management system.

PATENT  
Atty. Dkt. No. ROC920030266US1  
PS Ref. No.: IBMK30266

## EVIDENCE APPENDIX

Not Applicable.

PATENT  
Atty. Dkt. No. ROC920030266US1  
PS Ref. No.: IBMK30266

## RELATED PROCEEDINGS APPENDIX

Not Applicable.